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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,265	03/18/2004	Nikhil Jain	030259U3	7450

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QUALCOMM INCORPORATED
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SAN DIEGO, CA 92121

EXAMINER

TAYLOR, BARRY W

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/06/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary

Application No.

10/804,265

Applicant(s)

JAIN ET AL.

Examiner

Barry W. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-2, 4-5, 7-11, 13-16 and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Ahn et al (6,681,111 hereinafter Ahn) found in co-pending application 10/077,556 now abandoned.

Regarding claim 1. Ahn teaches a general global gateway configured to support communications between a first network and a second network (see CDMA and GSM figure 1) to enable a mobile station subscribed in the first network to communicate using the second network (title, abstract, col. 2 lines 36 – 46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col. 6 lines 32-54, col. 12 lines 39-47), comprising:

a database configured to store an identity of the mobile station (see 300 figure 1, col. 2 lines 36-46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col. 6 lines 32-54, col. 12 lines 39-47); and

a logic unit configured to execute program logic to obtain authentication information from the first network based on the identity of the mobile station (see 300 figure 1, col. 2 lines 36-46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col.

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6 lines 32-54, col. 12 lines 39-47) and further configured to determine whether authentication parameters from the MS satisfy GGG authentication criteria (see 300 figure 1, col. 2 lines 36-46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col. 6 lines 32-54, col. 12 lines 39-47).

Regarding claim 2. Ahn further shows a location register configured to store a location of the MS to enable a call incoming to the MS from the first network to route the incoming call to the MS through the GGG (see 300 figure 1, col. 2 lines 36-46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col. 6 lines 32-54, col. 12 lines 39-47).

Regarding claim 4. Ahn teaches a service center configured to send and receive messages to and from the second network according to a message format of the service center (i.e. Ahn describes a short message service (SMS) of the roaming service where the IRGS functions as the SMC/short message center --- col. 12 lines 39-42).

Regarding claim 5. Ahn teaches a second location register configured to store location of the MS to enable a call outgoing from the MS to the first network to route the outgoing call from the MS through the GGG (see 300 figure 1, col. 2 lines 36-46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col. 6 lines 32-54, col. 12 lines 39-47).

Regarding claim 7. Ahn teaches the service center is a short message service center (i.e. Ahn describes a short message service (SMS) of the roaming service where the IRGS functions as the SMC/short message center --- col. 12 lines 39-42).

Regarding claim 8. Ahn teaches wherein the messages deliver services that are provided by the first network that may not be provided by the second network (col. 1 lines 44-54).

Regarding claim 9. Ahn teaches wherein the SMSC is configured to send and receive SMS messages to validate a subscription in a network (i.e. Ahn describes a short message service (SMS) of the roaming service where the IRGS functions as the SMC/short message center --- col. 12 lines 39-42).

Regarding claim 10. Ahn teaches a general global gateway configured to support communications between a first network and a second network (see CDMA and GSM figure 1) to enable a mobile station subscribed in the first network to communicate using the second network (title, abstract, col. 2 lines 36 – 46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col. 6 lines 32-54, col. 12 lines 39-47), comprising:

means for storing an identity of the mobile station (see 300 figure 1, col. 2 lines 36-46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col. 6 lines 32-54, col. 12 lines 39-47); and

means for executing program logic to obtain authentication information from the first network based on the identity of the mobile station (see 300 figure 1, col. 2 lines 36-46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col. 6 lines 32-54, col. 12 lines 39-47) and determine whether authentication parameters from the MS satisfy GGG authentication (see 300 figure 1, col. 2 lines 36-46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col. 6 lines 32-54, col. 12 lines 39-47).

Regarding claim 11. Ahn teaches means for storing a location of the MS to enable a call incoming to the MS from the first network to route the incoming call to the MS through the GGG (see 300 figure 1, col. 2 lines 36-46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col. 6 lines 32-54, col. 12 lines 39-47).

Regarding claim 13. Ahn teaches wherein the SMSC is configured to send and receive SMS messages to validate a subscription in a network (i.e. Ahn describes a short message service (SMS) of the roaming service where the IRGS functions as the SMC/short message center --- col. 12 lines 39-42).

Regarding claim 14. Ahn further shows a location register configured to store a location of the MS to enable a call incoming to the MS from the first network to route the incoming call to the MS through the GGG (see 300 figure 1, col. 2 lines 36-46, col. 3 lines 62-65, col. 4 lines 17-33, col. 5 lines 28-46, col. 6 lines 32-54, col. 12 lines 39-47).

Method claim 15 is rejected for the same reasons as apparatus claim 1 since the recited apparatus would perform the claimed method steps.

Method claim 16 is rejected for the same reasons as apparatus claim 2 since the recited apparatus would perform the claimed method steps.

Regarding claim 18. Ahn teaches communicating directly from the MS to the first network after the MS has been authenticated (col. 2 lines 36-46).

Method claim 19 is rejected for the same reasons as apparatus claim 9 since the recited apparatus would perform the claimed method steps.

Method claim 20 is rejected for the same reasons as apparatus claim 2 since the recited apparatus would perform the claimed method steps.

Computer claim 21 is rejected for the same reasons as apparatus claim 1 and method claim 15 since the recited apparatus and method would perform the claimed program steps.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn et al (6,681,111 hereinafter Ahn) found in co-pending application 10/077,556 now abandoned in view of Hronek (6,564,055).

Regarding claim 6. Ahn does not use the term Internet.

Hronek teaches an intelligent roaming database (title, abstract) wherein the Internet is used (col. 10 lines 35-46) to allow for location information to be obtained

when a MS roams into a new region, as well as, offering MS low cost plans pertaining to specific roaming regions (col. 13 lines 31-40).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of Hronek into the teachings of Ahn in order to provide MS services when they roam into a new region, as well as, saving MS user money by offering the least expensive service plan to the MS user.

Response to Arguments

3. Applicant's arguments filed 12/16/06 have been fully considered but they are not persuasive.

a) Applicants generally argue that nowhere in Ahn is it taught or suggested that the IRGS 300 includes logic unit further configured to determine whether authentication parameters from the mobile station satisfy GGG authentication criteria (see paper dated 12/16/06, top of page 8).

The Examiner respectfully disagrees (see rejection listed above). The Examiner notes that Applicants figures and specification is confusing since Applicants do not clearly label figures. Applicants have not pointed anywhere in the specification to support such an argument. Applicants haven't argued what this means either? Therefore, the Examiner will try to "pinpoint" what is best understood to the Examiner. Ahn figure 3 clearly shows the IRGS (i.e. GGG) used to authenticate a mobile (150), which is currently registered to GSM network, but visiting a CDMA system (see bottom of figure 3 wherein mobile 150 roams to another service area). Next, the IRGS authenticates mobile by using the mobiles International Mobile Subscriber Identity which

clearly reads on Applicant general claim which only requires logic unit to determine whether GGG authentication criteria is satisfied.

b) Next, Applicants skip the Examiners rejection for dependent claim 6 (see bottom of page 8, paper dated 12/16/06). Therefore, the Examiner's rejection still holds.

Conclusion

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor, telephone number (571) 272-7509, who is available Monday-Thursday, 6:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost, can be reached at (571) 272-7872. The central facsimile phone number for this group is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (571) 272-2600, the 2600 Customer Service telephone number is (571) 272-2600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Centralized Delivery Policy: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the central fax number (571-273-8300).

Barry W. Taylor
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BARRY TAYLOR
PRIMARY EXAMINER